Claims 1 through 76 are pending.

Claims 1 through 76 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,745,711 to Kitahara et al. ("Kitahara") in view of U.S. Patent No. 5,737,491 to Allen et al. ("Allen"). This rejection is traversed for at least the reasons discussed below.

II. CLAIMS 1 THROUGH 76 ARE PATENTABILITY DISTINCT FROM KITAHARA AND ALLEN, ALONE OR IN COMBINATION

A. Claims 1 Through 10 And 52

Claim 1 recites:

> 1. A communication system comprising
>
> a plurality of transmission apparatuses for transmitting an image and a voice added to the image, and
>
> a reception apparatus for receiving the image and the voice,
>
> wherein said transmission apparatus comprises transmission means capable of selectively transmitting the image and the voice to said reception apparatus; and
>
> said reception apparatus comprises control means for controlling display statuses of the images received from said plurality of transmission apparatuses respectively and causing predetermined display means to display the controlled images, on the basis of the voice transmitted by said plurality of transmission apparatuses.

The Examiner alleges, at best understood, that each of the elements of claim 1 are found in Kitahara except "said reception apparatus comprises control means for ... causing predetermined display means to display the controlled images, on the basis of the voice

transmitted by said plurality of transmission apparatuses." The Examiner alleges that this feature is found in Allen. The Examiner is wrong on both counts.

1. Kitahara And Allen Do Not Teach, Disclose Or Suggest "Transmission Means Capable Of Selectively Transmit[ing] The Image And The Voice To Said Reception Apparatus," As Recited In Applicant's Claim 1

a. *Kitahara*

Kitahara is directed to a display control method and apparatus for an electronic conference. *See* coverpage at item [54]. According to Kitahara a workstation display (20A) and a telephone (10A) are connected via a LAN or ISDN (30) to other Workstations (20B and 20C) and other telephones (10B and 10C). *See* Figure 1. Kitahara discloses a communication interface (80) for coordinately controlling the interaction of these pieces. *See* Figure 2.

The Examiner does not allege that the electronic conference system of Kitahara "selectively transmit[s] the image and the voice to said reception apparatus," as recited in applicant's claim 1. This is because Kitahara discloses exactly the opposite:

> In the station B, the voice sounds and images of the stations A and C are received and generated as a sound or displayed. In the station C, the voice sounds and images of the stations A and B are received and generated as a sound or displayed. Similarly, in the station D, the voice sound and image of the station A are received and generated as a sound or displayed.
>
> (Col. 15, lines 39-45).

Thus it is clear that Kitahara teaches systematic transmission of voice and video data from each transmission site to all other sites receiving the teleconference.

b. *Allen*

Allen's electronic imaging system includes an image fulfillment server (34) with a central processing unit (37) that controls the digital camera (10) by processing a voice signal received from the microphone (24) using a voice recognition module (30). As clearly shown in figure 3, both the voice signal is processed by the voice recognition module (30) and converted into control signals. These control signals are then appended onto the image data. Col. 2, lines 45-51. Allen's transmission means does not transmit both the image and the voice signals, but instead only transmits a image signal.

Thus, Allen does not teach, disclose or suggest "transmission means capable of selectively transmit[ing] the image and the voice to said reception apparatus" as in Applicant's claim 1.

2. Allen Does Not Teach, Disclose Or Suggest "Causing Predetermined Display Means To Display The Controlled Images, On The Basis Of The Voice Transmitted By Said Plurality Of Transmission Apparatuses," As Recited In Applicant's Claim 1

Allen is directed to an electronic imaging system capable of image capture, local wireless transmission and voice recognition. The Examiner alleges that Allen "teaches image (and image server control) based on transmitted corresponding voice signal" and makes reference to Col. 1, lines 40-52 of that reference.

First, the Examiner has not alleged that Allen discloses the *claimed element.* Accordingly, it is irrelevant whether the Examiner's allegation regarding Allen is correct.

Second, Allen does not teach, disclose or suggest the claimed element. The passage cited by the Examiner relates to camera control based on voice recognition. As explained in Col. 4, lines 36-54, this feature of Allen permits a photographer to actuate a camera

and capture a digital image, engage a microphone and say "erase" to erase the image or "name (file name)" to append a file name to the image for storage. *See also* Table 1. From this passage it is clear that Allen is wholly unrelated to teleconferencing systems and is wholly unrelated to "display[ing] the controlled images, on the basis of the voice transmitted by said plurality of transmission apparatuses," as recited in applicant's claim 1.

Accordingly, at least claims 1-10 and 52 are patentably distinct from the cited references.

B. Claims 11 Through 20

Claim 11 recites "transmission means capable of [selectively] transmitting the image and the voice to said reception apparatus on the basis of control information transmitted from said reception means."

The Examiner does not specifically allege that this claim element is disclosed by either Kitahara or Allen.

In fact, as discussed above, Kitahara discloses systematic transmission of voice and video data from each transmission site to all other sites receiving the teleconference. Accordingly, Kitahara does not disclose this element.

Similarly, as also discussed above, Allen discloses that the digital camera (10) converts the voice signal to a control signal. This control signal is that transmitted to the image fulfillment server (34). Accordingly, Allen does not teach, disclose or suggest "control information transmitted from said reception means" and therefore, certainly does not teach, disclose or suggest "transmission means capable of transmitting the image and the voice to said reception apparatus on the basis of" such information.

Accordingly, at least independent claim 11 and dependent claims 12-20 are patentably distinct from the cited references.

C. Claims 21 Through 51 And 53-76

For at least similar reasons independent claim 21 and 24 are also distinct. *See, e.g.*, Claim 21 ("transmission means capable of transmitting the image and the voice to said reception apparatus"; "allocation means for allocating a control right to control an operation for any of said plurality of transmission apparatuses, on the basis of the voice transmitted from said transmission apparatuses."); *see also* claim 24 ("reception means capable of receiving the image and the voice added to the image"; "control means for ... displaying the controlled images on a predetermined display means, on the basis of the voice received by said plurality of transmission apparatuses").

Similarly, claim 34, which recites, *inter alia*, "reply means for returning the control information ... on the basis of the voice transmitted from said plurality of transmission apparatuses," is also distinct from the cited references.

Independent claims 21, 34, 44, 46-51, 53, 60-63, 67-69 and 73, and dependent claims 22-23, 25-33, 35-43, 45, 52, 54-59, 64-66, 70-72 and 74-76 are also patentably distinct from the cited references for at least similar reasons.

III. THE OFFICE ACTION IS INCOMPLETE; FINALITY MUST BE WITHDRAWN

The present office action dated May 18, 2000 and the previous Office Action dated September 2, 1999 fail as a matter of form to comply with the dictates of the Manual of Patent Examining Procedure. Specifically, the present application has 76 claims ***including 21***

independent claims. Yet, the present office action (and its predecessor) do not address most of these claims.

This failure to examine properly all of the pending claims of this application has hindered the advancement of the prosecution of this case. The applicant should not be left to guess at the examiner's rejection. In re Oetiker, 977 F.2d 1443, 1449 (Fed. Cir. 1992) ("The process of patent examination is an interactive one. The examiner cannot sit mum, leaving the applicant to shoot arrows into the dark hoping to somehow hit a secret objection harbored by the examiner.") (internal citation omitted)

For example, claims 46 and 49 recite "a control step of controlling display statuses of the images received from said plurality of transmission apparatuses and causing a predetermined display means to display the controlled images, on the basis of the voice received by said plurality of transmission apparatuses." No where in either of the office action has the Examiner alleged that the above-referenced claim element can be found in the prior art.

Importantly, the MPEP requires that Office Action completely state any grounds of rejection. MPEP § 707.07(d) (requiring the "ground of rejection [to be] fully and clearly stated") This was not done here.

Because both the present office action and its predecessor are incomplete as a matter of form, the rejections are void *ab initio* and finality must be withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, reconsideration and allowance are respectfully requested.

Respectfully submitted,

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